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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,941	03/31/2000	Hans-Detlef Luginsland	PM 258030/99003250	9776

909 7590 05/09/2002

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EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

FD-7

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/538,941		LUGINSLAND, HANS-DETLEF	
	<b>Examiner</b>		<b>Art Unit</b>	
	Rip A. Lee		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 1,5-7,9,11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5 and 6</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1 and 6 are objected to because of the following informalities: The claims recite the term “alkylidene.” The term alkylidene implies the presence of a double bond. While the Applicant may be his own lexicographer, the more accurate term, in view of claims 7 and 8, appears to be alkylene. Appropriate correction is required.
2. Claim 5 is objected to because of the following informalities: The claim recites the terms “propylidene” and “isobutylidene.” The more accurate terms are propylene and isobutylene, respectively (*vide supra*). Appropriate correction is required.
3. Claim 7 is objected to because of the following informalities: The first element of the Markush group is incomplete. In view of claim 8, it appears that the claim is drawn to the tetrasulfane species. Correction is required.
4. Claim 9 is objected to because of the following informalities: The syntax of the sentence is poor. The claim is drawn to a “Process...comprising at least one filler...” Processes involve performing a task, and thus, are modified with verbs, not objects. Correction is required.
5. Claims 11 and 12 are objected to because of the following informalities: The claims indicate that the moldings comprise a particular embodiment. The molding *is* a pneumatic tire, but it can not comprise a pneumatic tire. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed rubber mixture is comprised of “an alkylsilane.” According to the definition of claim 6, organosilanepolysulfanes are species of the genus alkylsilanes. That is, the *bis*(3-{dimethylethoxysilyl}propyl)tetrasulfane also qualifies as an alkylsilane. Thus, a rubber composition containing this compound alone would satisfy the requirements of claim 8. The claim should be amended if the claim is intended to relate to an alkylsilane other than the two organopolysulfanes recited in the same claim.

8. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim states that the molding comprises a pneumatic tire or a tire tread. The term “comprising” indicates that the composition has been made into an article other than said tire or tire tread, however, the additional article has not been disclosed in the claim. Without further qualification, these claims remain vague and indefinite.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,159,009 to Wolff *et al.*

Wolff *et al.* discloses rubber mixtures comprising at least one organosilicon compound of general formulae reproduced below (see claim 1 and claim 6).



In particular, group B represents –SCN, –SH, –Cl, or –S<sub>x</sub>– if *q* = 2. R and R1 represent an alkyl group containing 1-4 carbon atoms or a phenyl group. The mixture contains up to 15 % by weight of organosilicon compounds. The mixture contains reinforcing, synthetic fillers such as silicas and silicates (col. 3, line 44). As shown above, all present claims 1-8 are anticipated by the prior art.

*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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13. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,159,009 to Wolff *et al.* in view of U.S. Patent No. 6,008,295 to Takeichi *et al.*

The discussion of the disclosures of the prior art of Wolff *et al.* from paragraph 10 of this office action is incorporated here by reference. The rubber mixtures are used in "tire construction, *e.g.*, in the belt, carcass and bead areas (col. 4, lines 16-17)." The reference does not teach the use of rubber mixtures for tire treads, and it does not disclose a method of making such materials by molding the molding composition in a mold.

Takeichi *et al.* states that rubber mixtures are molded to form tire treads, undertreads, carcasses, side walls, beads, and the like (col. 11, lines 48-54). Thus, it would have been obvious to one having ordinary skill in the art to use the composition of Wolff *et al.* for making a tire

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tread in addition to other tire components. Also, as instructed in the prior art, it would have been obvious to mold the composition in a mold in order to manufacture said article(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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May 1, 2002

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700